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Dated: March 5, 2008

Signature: _____
(Susan Pagano)

Docket No.: 283_237.10 CPA
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Robert J. Hennick et al.

Application No.: 09/312,479

Confirmation No.: 2665

Filed: May 17, 1999

Art Unit: 2878

For: OPTICAL AND IMAGES SENSOR
SUBASSEMBLY ALIGNMENT AND
MOUNTING METHOD

Examiner: T. X. Luu

COMMUNICATION TO RECORD SUBSTANCE OF INTERVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

Remarks/Arguments begin on page 2 of this paper.

COMMUNICATION TO RECORD SUBSTANCE OF INTERVIEW

A telephone interview was conducted on March 3, 2008 between applicant's representative Dmitry Andreev and Examiner Thanh X. Luu. During the interview applicant's representative asserted that the "final" status of the Office action dated January 15, 2008 should be removed since in the January 15, 2008 Office action, several claims have been rejected for the first time over a full translation of a Japanese reference (JP 62-139465 to Azuma et al.), while in the previous Office action the claims were rejected over an abstract of the same reference. The applicant's representative noted that on at least two occasions the Court of Appeals for Federal Circuit has held that an abstract of a foreign publication and a full translation of the same publication were different references for the purposes of finding inequitable conduct on the part of the applicant for failing to submit a full translation¹.

In response, the Examiner stated that he did not rely on the full translation of Azuma for the claim rejections. The applicant's representative disagreed, noting that the plain language of the Office action referred to the full translation of Azuma. The Examiner offered to remove the references to the full translation while keeping the final status of the Office action.

If the Examiner believes that contact with applicant's representative would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicant's representative at the phone number listed below.

¹ While the two CAFC cases were not specifically referenced in the Interview for purposes of reducing the time of the interview, a concise summary is provided herein. In *Semiconductor Energy Laboratory v. Samsung Electronics*, 204 F.3d 1368 (Fed. Cir. 2000), CAFC upheld the district court's finding that failure to submit a full translation of a Japanese publication was inequitable conduct on the part of the applicant notwithstanding the fact that a partial translation and a full Japanese original have been timely submitted. In *Atofina v Great Lakes Chemical Co.*, 441 F.3d 991 (Fed. Cir. 2006), CAFC revisited the issue of whether inequitable conduct can be found where the applicant failed to submit a full translation of a foreign reference. While CAFC reversed the district court's finding of inequitable conduct, the reversal was based on the lack of clear and convincing proof of the applicant's deceptive intent, which, the Court held, could not be inferred from "the applicant's failure to disclose the full English translation of a foreign reference ... even if the full English translation went beyond the ... abstract." However, the mere fact that CAFC discussed the intent element at length, shows, in the applicant's opinion, that the Court saw an abstract and a full translation as potentially being two different references.

Application No. 09/312,479
Communication dated March 5, 2008
Interview dated March 3, 2008

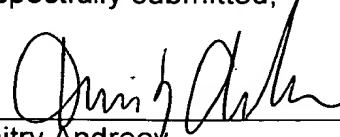
Docket No.: 283_237.10 CPA

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Dated: March 5, 2008

Respectfully submitted,

By



Dmitry Andreev

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